UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,061	06/24/2003	Uma M. Krishnamurthy	50-03-006	8656

34279 7590 07/02/2008

DOCKET CLERK, DM/EDS
P.O. DRAWER 800889
DALLAS, TX 75380

EXAMINER	
LOFTIS, JOHNNA RONEE	
ART UNIT	**PAPER NUMBER**
3623	
MAIL DATE	**DELIVERY MODE**
07/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/603,061	KRISHNAMURTHY ET AL.	
	Examiner	Art Unit	
	JOHNNA R. LOFTIS	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a non-final office action upon examination of application number 10/603,061. Claims 1-15 are pending and have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments with respect previous rejections under 35 USC 102 to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

3. With respect to previous rejection under 35 USC 112, 2nd paragraph, Examiner upholds this rejection. It is noted that the features upon which applicant relies (i.e., how migration percentages are calculated) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See modified rejections under 35 USC 112, 2nd paragraph, below.

4. In addition, based on Supreme Court precedent and recent Federal Circuit decisions new rejections under 35 USC 101 have been introduced.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4, 6, 9, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear how migration percentages are

determined based on averaged assessment factor ratings. Is there some mathematical step missing? Is there a reference chart? What guidelines does one follow to arrive at migration percentages after assigning ratings to the assessment factors?

7. Claims 1, 4, 6, 9, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps occur between the steps of averaging ratings and determining employee migration percentages. As claimed, it is not clear how the percentages are calculated once the ratings are averaged. Clarification is requested.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-5 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

10. An example of a method claim that would <u>not</u> qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the

subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-5 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Macken, JR. et al, US 2003/0055697.

As per claim 1, Macken teaches collecting application data (para. 0037 - questionnaire is distributed according to the process migration template); assigning ratings according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated); averaging the ratings to determine an average rating (para. 0039 – overall score is computed); and determining employee migration percentages according to the average rating (para. 0041 – full time employee values are determined with respect to the process migration template). While Macken teaches generating an overall score based on the ratings (para. 0039 and figure 4), the reference does not explicitly teach calculating an average rating. Examiner

takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious.

As per claim 2, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 3, Macken teaches applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., "0" corresponds to a difficult migration).

As per claim 4, Macken teaches determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 5, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management and application category (para. 0040 – a technology questionnaire is used).

As per claim 6, Macken teaches a data processing system (para. 0024) with means for collecting application data (para. 0037 - questionnaire is distributed according to the process migration template); assigning ratings according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated); and determining employee migration percentages according to the average rating (para. 0041 – full time employee values

are determined with respect to the process migration template). While Macken teaches generating an overall score based on the ratings (para. 0039 and figure 4), the reference does not explicitly teach calculating an average rating. Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious.

As per claim 7, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 8, Macken teaches a data processing system (para. 0024) with means for applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., "0" corresponds to a difficult migration).

As per claim 9, Macken teaches a data processing system (para. 0024) with means for determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 10, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management and application category (para. 0040 – a technology questionnaire is used).

As per claim 11, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for collecting application data (para. 0037 - questionnaire is distributed according to the process migration template); assigning ratings according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated); and determining employee migration percentages according to the average rating (para. 0041 – full time employee values are determined with respect to the process migration template). While Macken teaches generating an overall score based on the ratings (para. 0039 and figure 4), the reference does not explicitly teach calculating an average rating. Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious.

As per claim 12, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 13, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., "0" corresponds to a difficult migration).

As per claim 14, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 15, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management and application category (para. 0040 – a technology questionnaire is used).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Srinivasan et al, US 6,895,382 – method for arriving at an optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jl/
6/28/07
/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623